

## **REMARKS**

Reconsideration and withdrawal of the rejections of the claimed invention is respectfully requested in view of the amendments, remarks and enclosures herewith, which place the application in condition for allowance.

### **I. STATUS OF CLAIMS AND FORMAL MATTERS**

Claims 1, 3 and 5-14 are now pending in this application. Support for the amendment in claim 1 can be found on page 4, lines 21-23 of the specification. New claims 8-13 have been added to define different embodiments of the invention and new claim 14 is a combination of the limitations of claims 2 and 4. Support for the "brightness" limitation of claims 11-13 can be found, e.g., in paragraph [0006] or the corresponding publication of this application (U.S. Patent Application Publication 2007-0025121). No new matter has been added by this amendment.

It is submitted that the claims, herewith and as originally presented, are patentably distinct over the prior art cited in the Office Action, and that these claims were in full compliance with the requirements of 35 U.S.C. § 112. The amendments of the claims, as presented herein, are not made for purposes of patentability within the meaning of 35 U.S.C. §§§§ 101, 102, 103 or 112. Rather, these amendments and additions are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

### **II. THE 35 U.S.C. 103(a) REJECTION HAS BEEN OVERCOME**

1. Claims 1, 5, and 6 were rejected as allegedly being obvious by Jeon (6,729,737) in view of Harada (JP 2003-202415) and further in view of Funamoto (JP 11-250714). The applicants request reconsideration of this rejection for the following reasons.

In order to establish *prima facie* obviousness, all claim limitations must be taught or suggested by the cited references. *See MPEP 2143.03*. The Office Action acknowledged that Jeon does not teach a diffusing film with a columnar structure of 2 phase refractive indices at inclined angles between 5 and 60 degrees or a point light source. To address this deficiency, it was asserted that it would have been obvious to substitute the diffusing film of Jeon with the diffusing film of Harada. However, this observation is erroneous for the following reasons.

The surface light source of the invention addresses the problem that the use of a prism pattern in a surface light source can cause radial patterns of unevenness in the brightness of the surface light source. The applicants solved this problem by using the directional light diffusing film according to the invention, which is provided beside the light-outputting surface of the light

guide in such a way that the direction of diffusion of the directional light-diffusing film is in the same direction as the direction of the unevenness in brightness.

Both Jeon and Harada are silent on the problem of radial patterns of unevenness in the brightness of a surface light source caused by the directionality of the prism pattern. Specifically, in Harada (paragraph [0007]), it is stated that the optical film described therein is used to obtain a relatively bright image at a specific angle of the visual field (front direction). Accordingly, the film of Harada is used to improve the brightness for a limited viewing angle which may be desirable and acceptable for application where a broad viewing angle is not needed (e.g. a cell phone). In contrast, the applicants' claimed invention is used to correct patterns of unevenness caused by the use of a prism, i.e. a different problem which requires a different positioning of the light diffusing film than that suggested by Jeon, Harada or Funamoto.

As such, when considering these references as a whole, there was no reasonable expectation of success for taking elements out of Harada and replacing them into Jeon as they were directed to different invention from each other in addition to being different from the applicants' claimed invention, i.e. the process of modifying a reference to support a holding of obviousness cannot go so far as to render the reference inoperable for its own disclosed purpose which is what would occur with the attempted combination of Jeon and Harada.<sup>1</sup>

In addition, the Funamoto reference while being directed to a surface light source, is not clearly directed toward a surface light source which is akin to that taught by Jeon making it suitable for combination, i.e. there is no apparent likelihood of success for taking an isolated element from Funamoto and applying it to Jeon.<sup>2</sup> Funamoto deals with the problem of preventing diffusion patterns in the vicinity of a point light source in a surface light source device uniformly dispersing light emitted from one point light source through dispersion patterns so as to radiate in uniform luminance from a light radiation face, by arranging one point light source on one side end face of a light guide plate and forming diffusion patterns on the bottom face of the light guide plate. The diffusion patterns are arrayed fan-like centering the point light

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<sup>1</sup> "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) - see also MPEP 2143.01

<sup>2</sup> It has previously been held that "*it is impermissible* within the framework of section 103 *to pick and choose* from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." (see *In re Wesslau*, 353 F.2d 238, 241, 147 USPQ 391, 393 (CCPA 1965))

source, the pattern densities of the diffusion patterns are set to be large near the point light source, and the diffusion pattern densities are set to be gradually smaller as approaching the point light source.

For any of the above reasons, the claims are not *prima facie* obvious over Jeon, Harada and Funamoto.

2. Claims 2-4 were rejected as allegedly being obvious by Jeon, Harada, and Funamoto as applied above, in view of Shigmatsu (JP 2003-075611).

As claims 2-4 were dependent upon claim 1, the response to claim 1 above would also apply here. Furthermore, while there is an assertion that Shigamatsu teaches a light diffusing adhesion agent with microparticles, there is no direction or guidance from within Shigamatsu for selecting this particular element out of their invention as a whole for combination with other invention (especially when only the abstract is presumable relied upon), such as that referred to by Jeon and Funamoto. In addition, use of Shigamatsu requires even more improper “picking and choosing” as the applicants microparticles have specific properties associated with their microparticles, i.e. a diameter of 0.1 - 50  $\mu\text{m}$  whose refractive index is 1.55 or greater.

3. Claim 7 was rejected as allegedly being obvious by Jeon, Harada, and Funamoto, as applied to claim 1 above, in view of Karanaru (JP 2003-121656).

As claims 2-4 were dependent upon claim 1, the response to claim 1 above would also apply here. Furthermore, while there is an assertion that Kanaru teaches a light emitting unit positioned facing an angles end surface of the light guide, there is no direction or guidance from within Kanaru for selecting this particular element out of their invention as a whole for combination with other invention (especially when only the abstract is presumable relied upon), such as that referred to by Jeon and Funamoto.

**CONCLUSION**

In view of the remarks and amendments herewith, the application is believed to be in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited. The undersigned looks forward to hearing favorably from the Examiner at an early date, and, the Examiner is invited to telephonically contact the undersigned to advance prosecution. The Commission is authorized to charge any fee occasioned by this paper, or credit any overpayment of such fees, to Deposit Account No. 50-0320.

Respectfully submitted,  
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